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EXAMINER

LUONG, VINH

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/575,521	Applicant(s) DIETER, JUNG	
	Examiner Vinh T. Luong	Art Unit 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2008 and 26 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3656

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 3656.

2. The preliminary amendment filed on April 11, 2006 has been entered.

3. Applicant's election with traverse of Group I in the reply filed on October 27, 2008 is acknowledged. The traversal is on the ground(s), *inter alia*, that:

- (a) any search for Group I would necessarily include a search for Group II;
- (b) the objectives of streamlined examination and compact prosecution would be promoted if a search were conducted simultaneously for both Groups; and
- (c) the necessity of filing multiple patent applications in this case does not serve to promote the public interest because of the extra expense that is involved in filing fees and examination costs, as well as the burden upon the public due to the necessity of searching through a multiplicity of patent files in order to find the complete range of subject matter claimed in several different patents that could otherwise be found in one issued patent only.

This is not found persuasive because of the reasons, *inter alia*, listed below:

- (a) a search for Group I would not necessarily include a search for Group II. In the case at hand, claims 1-6, drawn to the selector lever, are classified in class 74, subclass 523, meanwhile, claims 7-10, drawn to the method for producing the selector lever, classified in class 29, subclass 434. Therefore, Group I would not require searching in class 29, subclass 434, meanwhile, Group II would not require searching in class 74, subclass 523. Put differently, the inventions I and II require different fields of search by employing different search queries due to

Art Unit: 3656

the fact that they have acquired a separate status in the art due to their recognized divergent subject matter;

(b) the objectives of streamlined examination and compact prosecution would not be promoted if a search were conducted simultaneously for both Groups. As noted in MPEP 802, 35 USC 121 states:

35 U.S.C. 121. Divisional applications.

If two or more *independent and distinct inventions* are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. (Emphasis added).

In addition, 37 CFR 1.141 states:

Different inventions in one national application.

(a) *Two or more independent and distinct inventions may not be claimed in one national application*, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim. (Emphasis added)

Here, if the search were conducted simultaneously for both Groups, there would be a serious burden on the Examiner due to, *inter alia*, different classes and subclasses as explained above. Moreover, there would be an additional serious burden on the Examiner to examine all of the claims since the Examiner would have to apply different references to patentably distinct inventions claimed in Groups I and II.

Art Unit: 3656

In addition, Applicant apparently conceded that the claimed inventions are patentably distinct. In fact, Applicant did not submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. If Applicant desires to achieve the objectives of streamlined examination and compact prosecution, the Examiner respectfully submits to follow the suggestion set forth in paragraph 3 on pages 3 and 4 of the restriction on September 29, 2008. Upon receiving Applicant's such evidence and/or admission, the Examiner would promptly withdraw the restriction requirement between Groups I and II to streamline the examination; and/or

(c) Applicant's arguments regarding the necessity of filing multiple patent applications and the burden upon the public due to the necessity of searching through a multiplicity of patent files in order to find the complete range of subject matter claimed in several different patents are equally applied to other similarly situated patent applications that claims patentably distinct inventions from other applicants. To waive the restriction requirement for this application based on this line of reasoning would be unfair to other complying applicants under 35 USC 121 and 37 CFR 1.141, *supra*.

On the other hand, Applicant would not need to file multiple patent applications to avoid the burden on the public of searching through Applicant's multiplicity of patent files by submitting evidence or identifying such evidence now of record showing the claimed inventions to be obvious variants or by clearly admitting on the record that this is the case. Upon receiving Applicant's such evidence and/or admission, the Examiner would withdraw the restriction requirement so that Applicant would not need to file a divisional application for Group II.

Art Unit: 3656

In view of the foregoing, the Examiner respectfully submits that the restriction requirement is deemed proper, and is therefore made FINAL.

4. Claims 8-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 27, 2008.

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The abstract of the disclosure is objected to because of the implied phrase "[t]he invention relates to." Correction is required. See MPEP § 608.01(b).

7. The drawings were received on October 27, 2008. These drawings are not accepted by the Examiner because the drawings are inconsistent with the specification and/or the claims. See 37 CFR 1.121(e). For example, the specification describes that the outer sleeve 14 is made of a thermoplastic elastomer. However, FIGS. 1 and 2 show that the sleeve 14 is made of metal in accordance with the drawing symbols in MPEP 608.02.

8. The *original* drawings are objected to because the drawings are not in compliance with 37 CFR 1.81. See Form PT-948 attached to the restriction requirement on September 29, 2008.

Art Unit: 3656

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

9. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because of the objection above. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

10. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant’s use.

Arrangement of the Specification

Art Unit: 3656

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

11. The disclosure is objected to because of the reasons, *e.g.*, listed below:

- (a) the specification should have appropriate headings listed above; and
- (b) the disclosure is inconsistent with the drawings. For example, the specification describes that the outer sleeve 14 is made of a thermoplastic elastomer. However, FIGS. 1 and 2 show that the sleeve 14 is made of metal in accordance with the drawing symbols in MPEP 608.02.

Appropriate correction is required.

Art Unit: 3656

12. Claim 6 is objected to because of the following informalities: the claim has typographical error, e.g., the recitation “expandable 5” should have been “expandable.” Appropriate correction is required.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms, such as, “rollable” in claim 1, “pivotable” in claim 2, “displaceable” in claim 3, and “expandable” in claim 6 are vague and indefinite in the sense that things which may be done are not required to be done. For example, in Claim 2, the lever is pivotable, but is not required structurally to be pivoted about two axes orthogonal to one another. See “discardable” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), “crimpable” in *Application of Collier*, 158 USPQ 266 (CCPA 1968), “removable” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and “comparable” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

It is unclear whether:

(a) a confusing variety of terms, such as, “a rolling body” and “two component sleeve 12” in claim 1 refers to the same or different things. See MPEP 608.01(o) and double inclusion in MPEP 2173.05(o); and

(b) the recitation “a rolling body (two-component sleeve 12)” in claim 1 claims “a rolling body,” or “two component sleeve,” or both of “a rolling body” and “two component sleeve.”

Art Unit: 3656

The term "so soft" in Claim 4 is a relative term which renders the claim indefinite. The term "so soft" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For example, it is unclear what range of Brinell or Rockwell hardness of the rolling body material is required so that it is considered to be "so soft."

Claim 5 recites the limitation "the selector lever shank." There is insufficient antecedent basis for this limitation in the claim.

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1-6, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Noriyasu (JP 10-24750 cited as X category reference in the International Search Report of Applicant's PCT related application).

Regarding Claim 1, Noriyasu teaches a selector lever (22, 38) which is guided within a gate shift slot (52, 54), wherein, in the region of the gate shift slot (52, 54), a rolling body (50) is arranged rotatably on the selector lever (22, 38) and is arranged so as to be rollable on the inner edge (FIGS. 3-7) of the gate shift slot (52, 58). *Ibid.* English abstract.

Regarding Claim 2, the selector lever (22, 38) is pivotable about two axes (20 and 28 in FIG. 2) orthogonal to one another.

Regarding Claim 3, the selector lever (22, 38) is transversely displaceable.

Art Unit: 3656

Regarding Claim 4, the rolling body (50) is so soft, at least on the outer circumference, that knocks of the rolling body (50) against the inner edge (FIGS. 3-7) of the gate shift slot (52, 58) are damped. *Ibid.* English abstract.

Regarding Claim 5, the rolling body (50) comprises at least two components (48 and 50, or 46 and 50 as seen in FIG. 1) which are connected rotationally fixedly to one another in the direction of rotation, in such a way that, during rolling, the rolling body (50) rotates in relation to a selector lever shank (22).

Regarding Claim 6, the rolling body (50) is expandable radially with respect to a longitudinal axis (22) of the selector lever (22, 38).

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Kwag (FIG. 3), Girard et al. (sleeve 4), and Takeshi et al. (FIGS. 1-11).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/

Primary Examiner, Art Unit 3656